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IN THE UNITED STATES DISTRICT COURT
DISTRICT OF UTAH, CENTRAL DIVISION

NATHAN T. CONK, Plaintiff, v. JORDAN OUTDOOR ENTERPRISES, LTD., HAAS OUTDOORS, INC., KING'S SHADOW CAMO, LLC, and CABELA'S, INC., Defendants.	Civil Action No. 2:10-CV-5-DB HONORABLE DEE BENSON **PLAINTIFF'S OPPOSITION TO DEFENDANT JORDAN OUTDOOR ENTERPRISES, LTD.'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY BASED ON ANTICIPATION**

Plaintiff Nathan T. Conk ("Conk") submits this memorandum in opposition to Defendant Jordan Outdoor Enterprises, Ltd.,'s ("Jordan") Motion for Summary Judgment of Invalidity Based on Anticipation and requests that the same be DENIED.

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I. Background

Plaintiff Nate Conk is an avid outdoorsman and hunting guide. One day, while looking at a poster with some sagebrush on it, the thought occurred to him that camouflage patterns could be designed to provide a three-dimensional look using photographs of actual elements from the environment in which the pattern would be used. Knowing little about digital photography, computer aided design, or printing, Mr. Conk set to work learning about these technologies in an attempt to see if he could indeed create a realistic looking camouflage pattern. After much hard work and study he succeeded. He applied for and was awarded two patents on his invention.

Over time, he observed that the camouflage industry adopted this technology. Before long, virtually every major player in the camouflage business was adopting patterns that included the concepts disclosed and claimed in Mr. Conk's patents. Jordan is one of those major players. Today it markets a number of different camouflage patterns which infringe Mr. Conk's patents.

II. Introduction

Like its co-defendant Haas Outdoors, Inc. ("Haas"), Jordan seeks to invalidate every asserted claim of both patents in suit.[1] Jordan alleges that each claim is anticipated under 35 U.S.C. Section 102(b) in view of Jordan's alleged prior use of one of its patterns. However, Jordan's motion suffers from the same defect as Haas' motion: it fails as a matter of law for lack of proof.

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[1] The claims asserted against Jordan are claims 1-8, 11-23, 26-37, and 40-43 of the '290 patent and claims 1-9 and 11-18 of the '879 patent. Thus, even if granted in full, claims 9, 10, 24, 25, 38, and 39 of the '290 patent would remain in the case against Haas.

Jordan claims that a pattern it identifies as "Realtree Hardwoods 20-200" was in public use prior to the critical date.[2] In support, it offers five things: (1) a declaration from Thomas Patterson, a long-time Jordan employee, (2) a Jordan copyright registration, (3) papers from a Jordan trademark application, (4) a magazine advertisement, and (5) an alleged program from the 1998 SHOT show. The Patterson declaration is legally insufficient to meet the clear-and-convincing evidence standard because it is uncorroborated oral testimony. The copyright registration certificate and the trademark statement of use are not evidence of prior use—they, like Jordan's motion, rely on an unsupported declaration of use. The other two items—the magazine advertisement (January 1999) and the alleged SHOT show program (February 1999)—are not dated more than a year prior to the critical date; thus, they fail to establish prior use under section 102(b) and are irrelevant to the present motion.

Other than the uncorroborated Declaration of Mr. Patterson, Jordan does not proffer ***any evidence*** showing what the alleged prior art pattern looked like or how it was made. Before any tribunal can find the claims anticipated, this threshold showing must be made. Like Haas, Jordan seeks to rely exclusively on Conk's Preliminary Infringement Contentions in applying the claims to the alleged prior art pattern. And, like Haas, Jordan ignores that these Preliminary Infringement Contentions are preliminary, that discovery of the accused patterns and methods is ongoing, and that Conk's infringement contentions may be modified before trial.

[2] 35 U.S.C. §102 states that a person shall be entitled to a patent unless, "(b) the invention was … in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States." Thus, the so-called "critical date" is one year prior to the filing date of the patent application. In this case, both patents in suit claim a filing date of November 8, 1999; thus, the "critical date" for both patents is November 8, 1998.

Further, Jordan also fails to note that one of the patents in suit is a method patent. For a prior use to anticipate method claims requires that the prior use or prior sale disclose the claimed methods. Jordan says nothing about this issue.

III. Response to Statements of Fact

Conk does not dispute paragraphs 1 through 5 and 7 of Jordan's Statement of Facts. Conk responds to paragraph 6 as follows:

> *JOEL's Hardwoods 20-200 pattern was available to the public as early as July 1998. See Declaration of Thomas Patterson at ¶¶ 4-6.*

Disputed as inadequately supported by the Patterson Declaration.

> *The Hardwoods 20-200 pattern, including an image of the pattern, was registered with the United States Copyright Office by JOEL on July 24, 1998. A copy of the Copyright Registration is attached as Exhibit C.*

Not disputed, except that there is no support for the contention that the image of the pattern registered with the United States Copyright Office was the same pattern allegedly placed in public use by Jordan.

> *Further, JOEL's application to trademark the term Hardwoods 20-200 contains a Statement of Use stating that goods bearing the Hardwoods 20-200 pattern were first used in commerce in July 1998.*

Not disputed.

> *In addition, the January 1999 issue of Shot Business (Vol. 7, No. 1) published an advertisement for Realtree Hardwoods 20-200, including photographs of the pattern.*

Not disputed, except that there is no support for the allegation identifying the photographs in the article, and the photographs themselves are blurry, indistinct, and in black-and-white.

> *In addition, the Realtree Hardwoods 20-200 pattern was introduced to the public at the SHOT show, an industry-wide hunting trade show, in February 1999.*

Disputed as inadequately supported by the Patterson Declaration.

Conk disputes paragraphs 8 and 9 because they are not supported by any citation to the record.

Conk offers the following additional statements of fact which are relevant to Jordan's motion:

1. The top of the second page of the Copyright Registration form includes the notation, apparently added by the Copyright Office: "*Added by the C.O. Authority per phone call with Laurence R. Radanovich on 1/6/99," indicating that the copyright application was still undergoing examination in January of 1999, well past the critical date of the patents in suit. *See* Exhibit C to Jordan's Memorandum.

2. Box 3(b) of the Copyright Registration form ("Date and Nation of First Publication of this Particular Work") was left blank by Jordan, an indication that Jordan had not yet "published" the work. *See* Exhibit C to Jordan's Memorandum.

3. Nothing in the Statement of Use of Jordan's trademark prosecution history discloses the actual pattern that allegedly was in public use. *See* Exhibit D to Jordan's Memorandum.

4. The *SHOT Business* magazine advertisement states it was published in February of 1999, three months ***after*** the critical date of the patents in suit. *See* Exhibit E to Jordan's Memorandum.

5. The *SHOT Business* magazine advertisement states: "For 1999, Realtree introduces our new Hardwoods™ pattern" and "Realtree Hardwoods will be introduced at the 1999 AMO Archery Trade Show and SHOT Show. Consumer promotions for Realtree Hardwoods will begin in February 1999 for its Spring release." These statements contradict Mr. Patterson's declaration that "[t]he Hardwoods 20-200 pattern was released into commercial use in 1998." *Compare* Exhibit E to Jordan's Memorandum to Patterson Decl. at ¶ 4.

6. The SHOT Show brochure is dated February 1999—***after*** the critical date of the patents in suit. *See* Exhibit F to Jordan's Memorandum.

IV. Argument

A. Summary Judgment Standard

Like Haas, Jordan neglects to note that issued patents are presumed valid under 35 U.S.C. § 282; thus, Jordan must demonstrate by clear and convincing evidence that the claims at issue are invalid. *Laryngeal Mask Co. Ltd. v. Ambu*, 618 F.3d 1367, 1373-74 (Fed. Cir. 2010) (reversing grant of summary judgment on invalidity); *ICU Med., Inc. v. Alaris Med. Sys.*, 558 F.3d 1368, 1376 (Fed. Cir. 2009); *Trimed, Inc. v. Stryker Corp.*, 608 F.3d 1333, 1340 (Fed. Cir. 2010) ("Because patents are presumed valid, a moving party seeking to invalidate a patent at summary judgment must submit such clear and convincing evidence of facts underlying invalidity that no reasonable jury could find otherwise.") (internal citations omitted).

B. Jordan's Motion Fails for Lack of Evidence

There are two patents in suit. The '290 patent includes only apparatus claims. The '879 patent includes only method claims. Haas claims that each asserted claim of both patents was "in public use" prior to the critical date of the two patents in suit.

If true, this would mean that a product disclosing each and every limitation of each asserted claim of the '290 patent was in public use before the critical date. Instead of supplying a claim chart applying each of the claim elements to the product(s) Jordan allegedly placed in public use, Jordan merely points to Conk's "Preliminary Infringement Contentions" and argues that the same products which now stand accused of infringement were in public use or on sale prior to the critical date of Conk's patents. Even if this logic were accurate (it is not),[3] Conk notes that its Preliminary Infringement Contentions are indeed preliminary, that discovery into the nature of the preliminarily accused patterns and methods is ongoing, and that Conk's infringement contentions may be modified before trial. And, even assuming that the contentions do not change, Jordan still has the burden to establish, by clear and convincing evidence, that the products it contends were in public use before the critical date are indeed identical in all ways specified by the asserted claims to the current products which stand accused of infringement. This it has not done. For at least this reason, Jordan's motion must fail.

With respect to the claims of the '879 method patent, the analysis is more complex. For a method claim to be invalidated as anticipated by a product in public use, the prior use must disclose each claimed step of the method. *W.L. Gore v. Garlock*, 721 F.2d 1540, 1549-50 (Fed. Cir. 1983). Further, simply because the method Jordan uses today may infringe does not mean that it used the exact same method before the critical date. Jordan offers no evidence about what

[3] In order for a third party's public use or sale to anticipate a claim, the public use or sale must disclose each and every limitation of that claim. *Novo Nordisk Pharmaceuticals, Inc. v. Bio-Tech. Gen'l Corp.*, 424 F.3d 1347, 1354-55 (Fed. Cir. 2005). Here, the claims are directed to camouflage and methods for making camouflage which include limitations such as "photographic images" ordered in a "synthetic perspective relationship." Even if Jordan sold a t-shirt prior to the critical date imprinted with an infringing camouflage that included such photographic images ordered in a synthetic perspective relationship, there remains a question of fact whether the t-shirt *discloses* those design elements. We do not and cannot reach that issue in this motion, however, because Jordan has not identified a single item it placed into public use or sale before the critical date.

methods it employed before the critical date or whether those methods are disclosed by the products it allegedly placed into public use at that time. And, as before, it remains unclear exactly what products Jordan placed in public use prior to the critical date. Thus, with respect to the method claims, Jordan's motion suffers from at least three fatal problems: (1) there is ***no evidence*** that each asserted method claim was disclosed by the alleged prior use, (2) there is ***no evidence*** of the methods employed by Haas before the critical date of the patents, and (3) as with the apparatus claims, there is ***insufficient evidence*** establishing what products were placed in public use by Jordan before the critical date.

C. Jordan has not established by clear and convincing evidence what products were in public use or on sale before the critical date

In a motion seeking to invalidate patent claims, the Court must compare the claims to the prior art. Before that can be done, however, the prior art has to be identified. Jordan claims through the unsupported declaration of Mr. Patterson that its Hardwoods 20-200 pattern was "released into commercial use in 1998" and it "would have been available to those in the industry at that time." Patterson Decl. ¶ 4. The critical date of the patents in suit is November 8, 1998. Mr. Patterson does not state ***when*** in 1998 the pattern was allegedly "released into commercial use." Anticipation under 35 U.S.C. § 102(b) as sought by Jordan requires that the prior art be placed into public use before the critical date. Even if Mr. Patterson's statement is accepted as true, it is impossible to determine from this record whether the alleged commercial use occurred before or after November 8, 1998; thus, it would be legal error to grant Jordan's motion on this record.

A more difficult problem for Jordan is that there is no evidence supporting the implied assertion in the Patterson Declaration that the Hardwoods 20-200 pattern released in 1998 is identical to the Hardwoods 20-200 pattern in use by Jordan today. Jordan does not identify a single item that was allegedly "in public use" in 1998. As such, Haas' showing is legally insufficient to invalidate any of the claims of Conk's patents. The identification of the alleged prior-art patterns is based solely on the testimony of Mr. Patterson. Because that testimony lacks corroboration, it fails as a matter of law.

1. Mr. Patterson's Testimony Requires Corroboration

The need for corroboration of such testimony was considered by the U.S. Supreme Court in 1892 when it took up the Barbed Wire patent case. *Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U.S. 275, 12 S.Ct. 443 (1892). In that case, twenty-four witnesses testified that they had seen the patented fence exhibited by a third party at a county fair more than two years prior to the filing of the patent. In reversing the holding of invalidity, the Court noted that the high evidentiary burden exists because "of the unsatisfactory character of testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury." *Id.* at 284. The Court held that such oral testimony required corroboration because "[w]itnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information." *Id.* at 284.

More recently, the Federal Circuit reached a similar conclusion in *Finnigan Corp. v. Int'l Trade Com'n*, 180 F.3d 1354 (Fed. Cir. 1999). In *Finnegan*, the ITC invalidated some claims of Finnegan's patent based on an article by one Keith B. Jefferts and on an alleged public use by Jefferts based on Jefferts' testimony at the hearing. *Id.* at 1360-61. On appeal, the Federal

Circuit considered the testimony of Jefferts' alleged public use. First, the Court noted that a witness's uncorroborated testimony is equally suspect as clear and convincing evidence whether he testifies concerning prior art under Section 102(a), (b), or (g). *Id.* at 1367. It then confirmed the need for corroboration regardless of the witness's interest in the outcome: "[T]he need for corroboration exists regardless whether the party testifying concerning the invalidating activity is interested in the outcome of the litigation (*e.g.*, because that party is the accused infringer) or is uninterested but testifying on behalf of an interested party." *Id.* Significantly, it then noted: "That corroboration is required in the former circumstance cannot be debated." *Id.* (*citing Stevenson v. Int'l Trade Comm'n*, 612 F.2d 546, 550 (C.C.P.A. 1979) ("Uncorroborated oral testimony of prior inventors or users with a demonstrated financial interest in the outcome of the litigation is insufficient to provide such proof.").

After reviewing Supreme Court precedent on the issue, the *Finnegan* Court stated: "[T]he Supreme Court has defined the necessity of corroboration not with reference to the level of interest of the testifying witness, but rather because of doubt that testimonial evidence alone in the special context of proving patent invalidity can meet the clear and convincing evidentiary standard to invalidate a patent." *Id.* at 1368. The Federal Circuit concluded that "corroboration is ***required*** of any witness whose testimony alone is asserted to invalidate a patent, regardless of his or her level of interest," (emphasis added) *id.* at 1369, and held that Jefferts' testimony "is insufficient ***as a matter of law*** to establish invalidity of the patent." *Id.* at 1370 (emphasis added). *See also Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371 (Fed. Cir. 1998) ("Corroboration of oral evidence of prior invention is the general rule in patent disputes."); *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 743 (Fed. Cir. 2002) (writing proffered to corroborate oral testimony "was insufficient as a matter of law to surmount the clear and convincing evidence hurdle.").

As with the Haas motion, Jordan's motion also rests solely on the testimony of a long-time company man. Because his testimony is relied upon to invalidate patent claims under the clear-and-convincing evidentiary standard, corroboration of his testimony is required. Jordan offers none; thus, its motion fails as a matter of law.

As explained below, the items attached to the Patterson Declaration do not provide the necessary corroboration.

2. The July 24, 1998 Copyright Registration Does Not Corroborate Mr. Patterson's Testimony

The copyright Certificate of Registration attached as Exhibit C to Jordan's memorandum is just a form completed by Jordan and submitted to the Copyright Office. There it was examined and stamped by the Copyright Office as an official registration. Jordan appears to rely on the form as evidence of its public use of the pattern. At most, the copyright form discloses that Jordan submitted a picture of a pattern to the U.S. Copyright Office in July of 1998. It says nothing about when the pattern was "released into commercial use," to quote Mr. Patterson.

Indeed, the top of the second page of the form includes the notation, apparently added by the Copyright Office: "*Added by the C.O. Authority per phone call with Laurence R. Radanovich on 1/6/99," indicating that the application was still undergoing examination in January of 1999, well past the critical date of the patents.

Also of note is that box 3(b) of the form ("Date and Nation of First Publication of this Particular Work") was left blank, an indication that Jordan had not yet "published" the work. This raises questions about when this pattern was allegedly "released." The copyright application, even when combined with Mr. Patterson's declaration, does not establish by clear and convincing evidence that the Hardwoods 20-200 pattern sold by Jordan today was "in public use" prior to the critical date of the patents. It fails to identify the pattern with clarity, it fails to tie any pattern sold in 1998 to the pattern sold today, and it fails to indicate what, if anything, was in public use as of any date certain.

At a minimum, many questions of fact are raised by the copyright application—questions which preclude the entry of summary judgment.

3. The June 29, 1998 Trademark Application Does Not Corroborate Mr. Patterson's Testimony

Jordan relies on the "Statement of Use" in the file history of its trademark application, presumably to provide proof that its Hardwoods 20-200 pattern was in public use prior to November 8, 1998. *See* Exhibit D to Jordan's Memorandum. The Statement of Use, however, is nothing more than a sworn statement signed by the applicant or a person authorized to sign on behalf of the applicant attesting to use of the mark in commerce. *See* 15 U.S.C. § 1051(d)(1)(a). Thus, the Statement of Use is nothing more than the Patterson Declaration—an uncorroborated statement. More significantly, the Statement of Use is a statement that the ***trademark*** was used in commerce, not that the Hardwoods 20-200 pattern was used in commerce. Even if it did, Jordan offers no argument that "use in commerce" under the Trademark Act is equivalent to "in public use" under 35 U.S.C § 102(b). Further, nothing in the Statement of Use discloses the actual pattern that allegedly was in public use. The use in commerce of a trademark before the critical date of the patents in suit has no impact on the patents' validity.

D. The Jordan Advertisement in the February 1999 issue of *SHOT Business* Magazine Does Not Corroborate the Patterson Declaration

The threshold problem with Jordan's advertisement in the February 1999 issue of *SHOT Business* magazine is that it states it was published in February of 1999, three months ***after*** the critical date. *See* Exhibit E to Jordan's Memorandum. Thus, it does not establish anything regarding events happening ***before*** the critical date.

Secondly, the *SHOT Business* magazine advertisement merely raises questions of fact. It states: "For 1999, Realtree introduces our new Hardwoods™ pattern" and "Realtree Hardwoods will be introduced at the 1999 AMO Archery Trade Show and SHOT Show. Consumer promotions for Realtree Hardwoods will begin in February 1999 for its Spring release." These statements are in stark contrast to Mr. Patterson's declarations, under oath, that "[t]he Hardwoods 20-200 pattern was released into commercial use in 1998." A Spring 1999 release of the pattern does not help Jordan get behind the November 1998 critical date.

E. The February 1999 SHOT Show Brochure Does Not Corroborate Mr. Patterson's Testimony

This brochure is dated February 1999—***after*** the critical date of the patents in suit. *See* Exhibit F to Jordan's Memorandum. Whether the Hardwoods 20-200 pattern was available to the public in February of 1999 SHOT Show is irrelevant to a motion seeking to invalidate claims having a November 1998 critical date. The SHOT Show brochure (Exhibit F to Jordan's Memorandum) does, however, appear to be consistent with the statements in the February 1999 *SHOT Business* article that the pattern was released in 1999, not in 1998 as alleged by Mr. Patterson. At a minimum, this creates issues of fact precluding the granting of Jordan's motion.

F. Even If The Alleged Prior-art Pattern Was In Public Use, Disclosure Of The Pattern Does Not Disclose The Claimed Methods

For the public use or sale by a third party[4] of an apparatus to invalidate a claim to a method for making that apparatus, the disclosure of the apparatus must disclose the method. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1993). In *W.L. Gore*, Gore sued Garlock for infringement of two patents. One included method claims, the other apparatus claims. The district court held the method claims invalid, finding that the invention was in public use and on sale by a third party (Budd) more than a year before Gore's application for patent. On appeal, the Federal Circuit found that it was error to hold that Budd's activity was a "public" use of the processes claimed in the patent, that activity having been secret, not public. *Id.* at 1549-50. The Court framed the question as follows: "Assuming, arguendo, that Budd sold tape produced on the Cropper machine before October 1969, and that the tape was made by a process set forth in a claim of the '566 patent, the issue under 102(b) is whether the sale would defeat Dr. Gore's right to a patent on the process inventions set forth in the claims." *Id.* at 1550. Answering that question, the Court noted: "If Budd offered and sold anything, it was only tape, not whatever process was used in producing it. ***Neither party contends, and there was no evidence, that the public could learn the claimed process by examining the tape.***" *Id.* (emphasis added).

If Jordan "publicly used" anything, it was only products bearing camouflage patterns, not the processes used in producing them. And, as in *W.L. Gore*, no one contends, and there is no

[4] In contrast, pre-critical date sales of a product *by the patentee* would invalidate claims directed to the method used to make that product. *Metallizing Engineering Co. v. Kenyon Bearing & AutoParts Co.*, 153 F.2d 516 (2d Cir. 1946) (J. Learned Hand).

evidence, that the public could learn the claimed processes by examining Jordan's products (assuming that some had been offered for inspection by the Court).

For example, claim 1 of the '879 patent recites "photographing scenes representative of a selected environment" and "separating selected images from the photographed scenes." It is difficult, if not impossible, to determine whether a camouflage pattern on a coat was created by using these two method steps merely by inspecting the coat. At a minimum, this creates a question of fact which precludes summary judgment. Of course, this analysis cannot be performed on any of the asserted claims of the '879 patent because Jordan has not identified any actual products that it placed into public use prior to the critical date of the '879 patent.

Because there is no evidence that Jordan disclosed the asserted method claims prior to the critical date of the '879 patent, Haas' motion fails with respect to these claims.

V. Conclusion

Jordan's motion rests solely on the testimony of a long-time Jordan employee. That testimony is contradicted by the very materials he relies on for corroboration. And, Jordan fails to disclose any specimens allegedly in existence before the critical date of the patents in suit

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which completely disclose the pattern allegedly placed in public use. Jordan's motion must fail as a matter of law.

DATED this 22nd day of November, 2010.

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